

REMARKS

Status of the Claims

Claims 1-2 and 4-12 are pending in the application. Claims 1 and 6 are currently amended. Reconsideration and allowance of all of the pending claims is respectfully requested.

New matter is not being added to the application by way of this amendment. The amendment to claim 1 is supported, for example, by Figures 6 and 8 of the specification which clearly illustrates that the portion substantially non-contributory to elastic extensibility and contractibility in the region inside the lateral sides of the patterned sheet are separate and distinct portions of an adjacent uncut elastic member from which they are cut.

Claim 6 is amended to be independent, and incorporates the subject matter of claim 1 as presented in the reply filed on July 27, 2007. The uniting the patterned sheet amendment to claim 6 is supported at page 10, lines 22-23 of the specification. Accordingly, no new matter is added and entry of this amendment is respectfully requested.

Provisional Request for Interview

Should the instant reply not result in allowance of each of instantly pending claims 1-2 and 4-12, the Examiner is respectfully requested to contact J. Mark Konieczny, Ph.D. (Reg. No. 47,715) at the telephone number of the undersigned (703-205-8000), so that further prosecution of the instant application can be expedited to allowance.

Rejection under 35 USC 103(a)

Claims 1-2 and 4-12 stand rejected under 35 USC 103(a) as being unpatentable over **JP ‘528** (JP 2002/159528; US Patent Publication 2004/0030317 is used as the English equivalent). Applicants respectfully traverse this rejection for the following reasons.

1. Legal Standard for Determining Prima Facie Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The Supreme Court of the United States has recently held that the teaching, suggestion, motivation test is a valid test for obviousness, but one which cannot be too rigidly applied. See *KSR International Co. v Teleflex Inc.*, No. 04-1350, slip op. at 11 (U.S. April 30, 2007).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success cannot be found in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

“In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be

sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification.” *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to combine or modify the references. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

2. Distinctions between the present invention and the cited art

Applicants respectfully submit that the prior art does not disclose or suggest all of the limitations of claim 1. The prior art does not disclose or suggest an absorbent article with separate and distinct portions of an adjacent uncut elastic member in the widthwise middle area of at least one of the front portion or the rear portion, such that a portion of the separate and distinct portions have cut ends of elastic members or a fragment of the elastic members or both. Accordingly, because the prior art does not disclose or suggest all of the limitations of the

present claims, a *prima facie* case of obviousness has not been established, and the pending prior art rejection of claim 1 and its dependent claims must be withdrawn.

JP '528 discloses an absorbent article in which the elastic members are not arranged in the widthwise middle area of the absorbent core, but are in fact arranged at right and left side portions of the absorbent core. JP '528 does not disclose or suggest separate and distinct portions disposed in the widthwise middle area of the absorbent core as presently claimed. Present claim 1 recites that separate and distinct portions of an adjacent elastic member are disposed such that a portion of the separate and distinct portions have cut ends of elastic members or a fragment of the elastic members extend into the widthwise middle area of the absorbent core.

Furthermore, in JP '528 the cut elastic members are arranged in a stretched state and therefore also do not have a "portion substantially non-contributory to elastic extensibility and contractibility in the region inside the lateral sides of the patterned sheet" as presently claimed. Applicants submit that this fact would be immediately apparent to one of skill in the art. JP '528 does not disclose or suggest the cut elastic members recited in claim 1.

The Examiner asserts at pages 2 and 3 of the Office Action that there is no "significant difference between cut ends and cut fragments as it relates to the same invention." The Examiner further asserts that: the elastic materials of JP '528 has cut ends which would also fragment the material providing cut fragments of the elastic in the article. See Office Action, page 3.

However, applicants respectfully disagree with the Examiner's assertions. In particular, applicants note cut fragments 24 at Figures 3 and 6d of the present specification. Such cut fragments are in direct contrast to the embodiment depicted at Figure 1 of the U.S. 2004/0030317 publication of JP '528. Applicants respectfully submit that the Examiner may be

mistaking the dashed lines at Figure 1 of U.S. 2004/0030317 as being cut fragments. The Examiner also makes reference to Figures 32 and 34 of U.S. 2004/0030317 in this regard. See page 4 of the Office Action. However, applicants submit that U.S. 2004/0030317 does not show cut fragments in the widthwise middle area of at least one of the front portion and the rear portion in any of the cited Figures.

Accordingly, JP '528 does not disclose or suggest all of the limitations of the present claims. Applicants submit that a proper *prima facie* case of obviousness has not been established, and that this rejection must therefore be withdrawn.

3. Claim 6

Claim 6 recites a patterned sheet that is disposed between an outer sheet and an inner sheet, and elastic members that are disposed between the patterned sheet and the inner sheet. The components are pressed with a pressing member to cut the elastic members. The dots of claim 6 are formed by projections of the pressing member. By pressing the heated projections the patterned sheet, the outer sheet, and the inner sheet are united under each dot. Applicants respectfully refer the Examiner, for example, to page 10, lines 22-23 of the specification. Unless the sheets are united as described above, clear see-through visibility of the pattern from the outside is not obtainable, and the appearance of the article becomes unattractive. Applicants submit that the prior art does not disclose or suggest uniting the sheets as presently recited in claim 6. Accordingly, a *prima facie* case of obviousness with respect to claim 6 is not established and this rejection must be withdrawn.

Conclusion

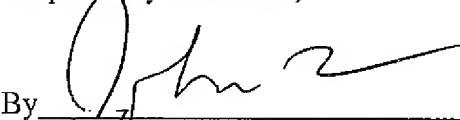
Applicants respectfully submit that JP '528 does not disclose or suggest all of the limitations of the present claims and that a *prima facie* case of obviousness has not been established. An early reconsideration and Notice of Allowance indicating the allowablity of pending claims 1, 2, and 4-12 is respectfully requested.

Should the Examiner have any questions regarding the instant reply, or wish to set up an interview to expedite further prosecution of this case to allowance, she is respectfully requested to contact **J. Mark Konieczny, Ph.D.** (Reg. No. 47,715) at the telephone number indicated below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,



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